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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,146	06/14/2002	Mark A. Kappel	126063	3242
27256	7590	12/08/2005	EXAMINER	
ARTZ & ARTZ, P.C. 28333 TELEGRAPH RD. SUITE 250 SOUTHFIELD, MI 48034			PHAN, THIEM D	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/064,146	Applicant(s) KAPPEL ET AL.	
	Examiner Tim Phan	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 9 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. In view of the Appeal Brief filed on 9/16/05, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

*Marc Jimenez*  
*Acting SPE AU 3726/3726*

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Greco (US 4,215,468).

**As applied to claim 1**, Greco teaches an IC extracting tool, comprising:

- a piston assembly (Fig. 6, 10) having a channel therethrough (Fig. 11, around 48, 41 & 22);
- a cross-member (Fig. 6, 22) slidably receiving said piston assembly, said cross-member having a slot for pins (Fig. 7, 23) therein, said cross-member having a post head (Fig. 7, 20) sized to be received within said retraction feature; and
- a pin (Fig. 7, 30) positioned within said channel and slidably received within said slot.

**As applied to claim 2**, Greco teaches a piston (Fig. 6, 43) having a first and second end (Fig. 6, ends of 43).

**As applied to claim 3**, Greco teaches that the piston assembly has a handle (Fig. 6, 40) disposed on a first end.

**As applied to claim 4**, Greco teaches that a channel (Fig. 11, around 41 & 22) is disposed on a second end of the piston (Fig. 11, bottom of 43).

**As applied to claim 5**, Greco teaches that the piston assembly comprises a grip (Fig. 6, 33) having an opening (Fig. 6, around 41) therethrough for slidably receiving said piston (Fig. 6, 43) therethrough.

**As applied to claim 6**, Greco teaches a spring (Fig. 6, 41) positioned on said piston between said handle and said grip, said spring urging said handle away from said grip.

**As applied to claim 7**, Greco teaches a first and second post (Fig. 7, 20).

**As applied to claim 8**, Greco teaches that the pin (Fig. 7, 30) has an angular shape.

**As applied to claim 10**, Greco teaches an IC extracting tool, comprising:

- a piston (Fig. 6, 43) having a handle (Fig. 6, 40) disposed on a first end and a channel (Fig. 11, around 41 & 22) disposed on a second end;
- a grip (Fig. 6, 33) having an opening (Fig. 6, around 41) therethrough for slidably receiving said piston;
- a spring (Fig. 6, 41) positioned on said piston between said handle and said grip, said spring urging said handle away from said grip;
- a sleeve (Fig. 11, 12) adjacent to the grip for slidably receiving the piston;
- a cross-member (Fig. 7, 22) adjacent to said sleeve, said cross-member having a slot (Fig. 7, 23) therein, said cross-member having a post head (Fig. 7, 20); and

- a pin (Fig. 7, 30) positioned within said channel and slidably received within said slot.

As applied to claim 11, Greco teaches that the post comprises a first post and a second post (Fig. 7, 20).

As applied to claim 12, Greco teaches that the pin (Fig. 7, 30) has an angular shape.

#### *Allowable Subject Matter*

4. Claims 9 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Response to Arguments*

5. Applicants' arguments with respect to claims 1-8 and 10-12 have been considered but are moot in view of the new ground of rejection.

This Office Action is a **non-Final** Office Action.

*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Phan whose telephone number is 571-272-4568. The examiner can normally be reached on M - F, 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tim Phan  
Examiner  
Art Unit 3729

tp  
December 5, 2005

  
MARC JIMENEZ  
PRIMARY EXAMINER  
12/5/05